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EXAMINER

JAMAL, ALEXANDER

ART UNIT PAPER NUMBER

2643

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,778

Applicant(s)

DESHPANDE ET AL.

Examiner

Alexander Jamal

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to notice for appeal***

1. Based upon the submitted notice for appeal and request for appeal conference, the examiner notes that only arguments have been submitted.
2. Examiner withdraws the finality of the final office action filed 6-13-2005.
3. Examiner maintains the current set of rejections and responds to applicant's arguments below.
4. Examiner submits an additional set of rejections based upon newly discovered prior art.
5. Examiner further notes patent Tran (6496693), that is applicable to applicants claimed invention.

### **Original rejection**

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the

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United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1,2,14-16, 21-22** rejected under 35 U.S.C. 102(e) as being anticipated by Waites (6788769).

As per **claim 1**, Waites discloses a communication system that may comprise an IM system (Col 1 lines 10-20). The system comprises an origin device where a user is able to input text or speech (Col 3 lines 29-46) or convert input speech to text in order to be transmitted (Col 9 lines 36-50).

As per **claim 14**, claim rejected for same reasons as rejection of claim 1. Additionally, Waites' originating device inherently comprises a controller to determine whether a speech option is selected for the purpose of being able to correctly coordinate the operation of the IM server interface and the speech-to-text converter.

As per **claim 21**, claim rejected for same reasons as rejection of claim 19. The terminals inherently comprise software on a signal bearing medium for the purpose of controlling the terminal hardware.

As per **claims 2,22** claims rejected for same reasons as claim 1,21 rejections.

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As per **claim 15**, when the IM transmitted, it will be sent/received across a long-lived connection (the interface between the sending terminal and the network connected to the IM server).

As per **claim 16**, the IM server will pass along an IM to the destination device.

**8. Claims 6-10,12** rejected under 35 U.S.C. 102(e) as being anticipated by Andrews et al (6522878).

As per **claims 6,7**, Andrews discloses a method comprising receiving an instant message (alphanumeric page) comprising text at a destination device, then converting that text into speech if the speech option is selected (pager mode announce) (Col 4 lines 12-22).

As per **claims 10,8**, claims rejected for same reasons as claim 6. Additionally, Andrews' method will receive and convert the text independently of the manner in which the sender of the page input the text.

As per **claims 9,12**, when the page is transmitted and received via the cellular network, the pages will be sent/received across a long-lived connection (the interface between the cellular access point and the cellular network).

***Claim Rejections - 35 USC § 103***

**9.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claims 3-5,18,23-25** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claims 1,2,14,21,22, and further in view of Andrews (6522878).

As per **claim 3**, Waites discloses applicant's claims 1,2,14,21,22, but does not specify that the receiving pager comprise a speech option to convert incoming text into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20). He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40). It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 4**, claim rejected for same reasons as claim 3 rejection.

As per **claims 5,25**, the message delivery interface at the receiving device is independent of the message inputting interface at the sending device.

As per **claims 18,23,24**, claim rejected for same reasons as claim 3 rejection.

**11. Claims 19,20,26-29**, rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769), and further in view of Andrews (6522878).

As per **claim 19**, Waites discloses an IM system as per the claim 1 rejection. However, Waites does not disclose the destination client device comprising a text-speech converter to convert the received messages into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20). He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40) independently of how they were sent. It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 26**, claim rejected for same reasons as rejection of claim 19.

As per **claim 20**, claim rejected for same reasons as claim 19.

As per **claim 27**, claim rejected for same reasons as claim 1.

As per **claim 28**, claim rejected for same reasons as claim 15.

As per **claim 29**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

**12. Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claim 14, and further in view of Ogle et al. (6430604).

As per **claim 17**, Waites discloses applicant's claim 14, but does not specify that the IM server drops the messages when no destination client device is connected.

Ogle discloses an IM system in which the messages may be dropped if the receiving device is not available (Col 3 lines 20-35). It would have been obvious to one of ordinary skill in the art at the time of this application that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.

**13. Claims 11,13** rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al (6522878) as applied to claim 10, and further in view of Waites (6788769).

As per dependant **claim 11**, Andrews discloses applicant's claim 10 but does not disclose determining whether a speech option is chosen at the origin (sender) device and when selected, converting input speech to text.

Waites discloses a communications system that may comprise instant messaging (paging) (Col 1 lines 10-20). He discloses that the user may be able to dictate a voice message that is sent through a speech-to-text converter (Col 9 lines 35-51). It would have been obvious to one of ordinary skill in the art at the time of this application that the sending device could comprise a speech-to-text converter for the purpose of providing an additional interface for the sender (ie. the sender may dictate a voice message that may be sent to a receiving pager).



As per **claim 13**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

**New set of claim rejections**

***Claim Rejections - 35 USC § 102***

**14.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**15. Claims 1,4-16,18-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Parvulescu et al. (5724410).**

As per **claim 1**, Parvulescu discloses a system and method for transmitting instant messages (ABSTRACT). A speech option is determined at an originating terminal based upon the user's selection of the receiving terminal (Col 4 line 41 to Col 5 line 12). If the speech option is selected the input speech is converted to text and transmitted as an instant message (page) (Col 5 lines 10-20).

As per **claim 6**, the claim is rejected for the same reasons as claim 1. The user of the receiving terminal may receive a text message and choose to have the message displayed as text or converted to a voice format (Col 6 lines 25-42).

As per **claim 10**, the claim is rejected for the same reasons as claim 6. The choice of the voice or speech option at the receiving device is independent of the speech option of the origin device.

As per **claims 14,16,19**, the claims are rejected for same reasons as claim 10. The device may be used with a paging system that inherently comprises an instant message server for the purpose of relaying the instant message (page). The respective sending and receiving terminals each inherently comprise 'controllers' for the purpose of allowing the users the ability of using the speech option or text option at each respective end.

As per **claims 21-25** the claims are rejected for same reasons as claim 14. The sending/receiving terminals inherently comprise software for the purpose of controlling the hardware.

As per **claims 26,27**, the claims are rejected for same reasons as claim 14.

As per **claims 4,7**, the user of the receiving terminal may receive a text message and choose to have the message displayed as text or converted to a voice format (Col 6 lines 25-42).

As per **claims 5,8,20**, the choice of the voice or speech option at the receiving device is independent of the speech option of the origin device.

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As per **claims 9,12,15,28**, the system operates as a pager and as such, is over a long-lived connection.

As per **claims 11,18**, the claims are rejected for same reasons as claims 1 and 14.

As per **claim 13,29**, the terminal may communicate the message via a request reply pair via the computer/modem, or fax machine (Col 5 lines 40-55).

***Claim Rejections - 35 USC § 103***

**16.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**17. Claims 2,3** rejected under 35 U.S.C. 103(a) as being unpatentable over Parvulescu et al. (5724410) as applied to claim 1, and further in view of Brunet et al (5995590).

As per **claims 2,3** Parvulescu discloses a pager system as per the claim 14 rejection above, but does not disclose the pager terminal comprising a text input means in the event that the speech-to-text option is not selected.

Brunet discloses a communications terminal with a paging function (see Figure 14 items 32A,12A) that further comprises a keyboard or stylus for selectable text based input. Brunet further discloses that a text input feature allows users to carry on conversations unobtrusively (Col 1 lines 20-30). It would have been obvious to one of

ordinary skill in the art at the time of this application that a direct text input method could be implemented with the terminal of Parvulescu for the purpose of allowing users to carry on conversations unobtrusively.

**18. Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Parvulescu et al. (5724410) as applied to claim 14, and further in view of Ogle et al. (6430604).

As per **claim 17**, Parvulescu discloses applicant's claim 14, but does not specify that the IM server drops the messages when no destination client device is connected.

Ogle discloses an IM system in which the messages may be dropped if the receiving device is not available (Col 3 lines 20-35). It would have been obvious to one of ordinary skill in the art at the time of this application that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.

### **Response to Arguments**

**19.** Applicant's arguments with respect to claims 1-29 (as filed in the pre-appeal brief request for review 10-17-2005 and applied to the first set of rejections) have been considered but are not persuasive.

As per applicant's argument that Waites does not disclose transmitting an instant message (remarks page 7), Waites discloses that the directory messaging system may be used with an instant messaging system (Col 2 lines 55-65).

As per applicant's argument that the 'instant messaging' referred to by Waites is a 'broad reference to the field of electronic communications' (remarks page 8), examiner respectfully disagrees. Waites discloses 'instant messaging' as a 'diverse communication mechanism' (Col 2 lines 55-65), which is not a 'broad reference to the field of electronic communications'. Furthermore, Waites discloses a paging system, and, as per applicant's specification, and as per applicant's claim language, a paging system is an instant messaging system.

As per applicant's argument that the system of Waites does not inherently comprise a 'controller' (remarks page 9) or software in the communication terminals. Examiner reads a controller as any means to perform the disclosed functions of the disclosed terminals in Waites (Col 9 lines 35-50). Additionally, examiner maintains that all modern (at filing date of this application) digital communications terminals inherently comprise software for the purpose of controlling the hardware for its intended function. Additional support for the use of software is disclosed in (Col 9 lines 35-50).

As applicant's arguments that Andrews does not disclose an instant message (remarks page 10), examiner reads an 'instant message' as a page signal and as such, it is disclosed by Andrews.

As per applicant's argument that there is insufficient motivation to combine Andrews with Waites (Remarks pages 10-13), examiner maintains that providing an additional (and well known) user interface to the terminals disclosed by Waites user is sufficient motivation to combine the references.

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As per applicant's argument that there is insufficient motivation to combine Ogle with Waites (Remarks pages 12-13), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner contends that it would have been obvious to one skilled in the art at the time of the application that an infinite number of messages could not be stored on a server of limited storage capacity. As such, a system that could potentially get an unlimited number of message requests comprises an inherent need to manage the incoming messages in a manner that keeps the system functioning. If unlimited messages were allowed to accrue then the system would cease to function when all available storage space was used up.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498. The examiner can normally be reached on M-F 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 571-272-7499. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and **571-273-8300** for After Final communications.

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As per applicant's argument that there is insufficient motivation to combine Ogle with Waites (Remarks pages 12-13), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner contends that it would have been obvious to one skilled in the art at the time of the application that an infinite number of messages could not be stored on a server of limited storage capacity. As such, a system that could potentially get an unlimited number of message requests comprises an inherent need to manage the incoming messages in a manner that keeps the system functioning. If unlimited messages were allowed to accrue then the system would cease to function when all available storage space was used up.

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AJ

November 16, 2005

  
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